

U.S.S.N. 09/808,610

Remarks

Claims 19-35 stand rejected under 35 U.S.C. § 103 over JP SHO 50-10353 (JP '353) in view of U.S. 4,151,056 issued to Park ("Park").

JP '353 discloses coating the edge face of a roll of tape with a solution that includes an organic solvent and either a crosslinkable photosensitizer or a crosslinkable photosensitizer, a photoactive crosslinking agent and, optionally, a vinyl-based polymer. JP '353 discloses that a very thin region at the surface of the pressure sensitive adhesive on the edge face of the tape is formed into a cured layer by means of crosslinking.

Park discloses that radiation curable coating compositions of the prior art typically contain a radiation reactive oligomer or resin, a radiation reactive diluent, a photoinitiator and optionally a radiation reactive crosslinker. Park also discloses a radiation curable coating composition that includes a radiation curable oligomer or resin, an alkanedione or cycloalkanedione, and optionally a photoinitiator and a crosslinker.

Claim 19 is directed to a roll of pressure sensitive adhesive tape that includes a first nontacky edge face, a second edge face, and a coating disposed on the first edge face, the coating including the reaction product of acrylate oligomer, polyetheracrylate oligomer, and, optionally monomer, photoinitiator or a combination thereof. It is undisputed that JP '353 fails to teach or suggest a coating disposed on an edge face of a roll of tape, where the coating includes the reaction product of acrylate oligomer and polyetheracrylate oligomer. Instead, JP '353 discloses detackifying the pressure sensitive adhesive present at the edge face of a roll of tape by crosslinking the portion of the pressure sensitive adhesive that is exposed at the edge face of the roll of tape.

Park does not cure the deficiencies of JP '353. To establish a prima facie case of obviousness based upon a proposed combination of references there must be a teaching, suggestion or motivation in the prior art for making the proposed combination. See M.P.E.P. 2142; Fromson v. Anitec Printing Plates, Inc., 132 F.3d 1437 (Fed. Cir. 1997); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, (Fed. Cir. 1998). Here there is no such teaching, suggestion or motivation. Park does not teach a composition that includes the reaction product of acrylate oligomer and polyetheracrylate oligomer. Nothing in the record establishes anything to the contrary. Applicant previously specifically requested that, if the rejection of claim 1 was maintained, the Office action expressly identify the

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passage in Park, by the column and line number, that provides a teaching of a composition that includes the reaction product of both an acrylate oligomer and a polyetheracrylate oligomer. Applicant further requested that the Office action identify the passage in Park that suggests selecting a composition that includes the reaction product of an acrylate oligomer and a polyetheracrylate oligomer for use on the edge face of a roll of pressure sensitive adhesive tape. It is telling that no such information has been provided. Instead, the Office action contains a statement regarding an inherent disclosure. Applicant takes this statement to constitute a concession on the part of the Examiner that Park does not expressly teach a composition that includes the reaction product of acrylate oligomer and polyetheracrylate oligomer. In addition, Applicant understands that the rejection relies upon inherency to establish the teaching necessary to carry the Examiner's burden of establishing a prima facie case of obviousness. Ignoring the fact that inherency is not a proper basis for a rejection under 35 U.S.C. § 103 (see, M.P.E.P. 2112; In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993); In re Spormann, 53 C.C.P.A. 1375, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966); In re Newell, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989)), the Examiner's concession establishes that it is uncontradicted that neither JP '353 nor Park teaches a composition that includes the reaction product of acrylate oligomer and polyetheracrylate oligomer. Therefore, it cannot be disputed that the proposed combination of JP '353 and Park lacks a required element of claim 19. Moreover, because the proposed combination of JP '353 and Park contains no teaching of a composition that includes the reaction product of acrylate oligomer and polyetheracrylate oligomer, the skilled artisan could not possibly think to select such a composition for use on the edge face of a roll of tape. For at least these reasons, a prima facie case of obviousness has not been established and the rejection of claims 19-35 under 35 U.S.C. § 103 over JP '353 in view of Park must be withdrawn.

Claims 20-35 are distinguishable over the proposed combination of JP '353 and Park for at least the same reasons set forth above in distinguishing claim 19. Applicant submits, therefore, that the rejection of claims 20-35 under 35 U.S.C. § 103 over JP '353 in view of Park is unwarranted and requests that it be withdrawn.

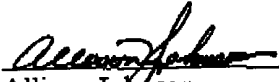
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The claims now pending in the application are in condition for allowance and such action is respectfully requested. The Examiner is invited to telephone the undersigned should a teleconference interview facilitate prosecution of this application.

Please charge any additional fees owing or credit any over payments made to Deposit Account No. 501,171.

Respectfully submitted,

Date: June 27, 2003


Allison Johnson
Reg. No. 36,173

Allison Johnson, P.A.
6016 Logan Ave. S.
Minneapolis, MN 55419
Telephone (612) 861-8621
Facsimile (612) 861-8628

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JUN 30 2003
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